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APR 9

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

No. ~~1130~~ 7/

UNITED CARBON COMPANY AND UNITED CARBON COMPANY, INC.,

Petitioners,

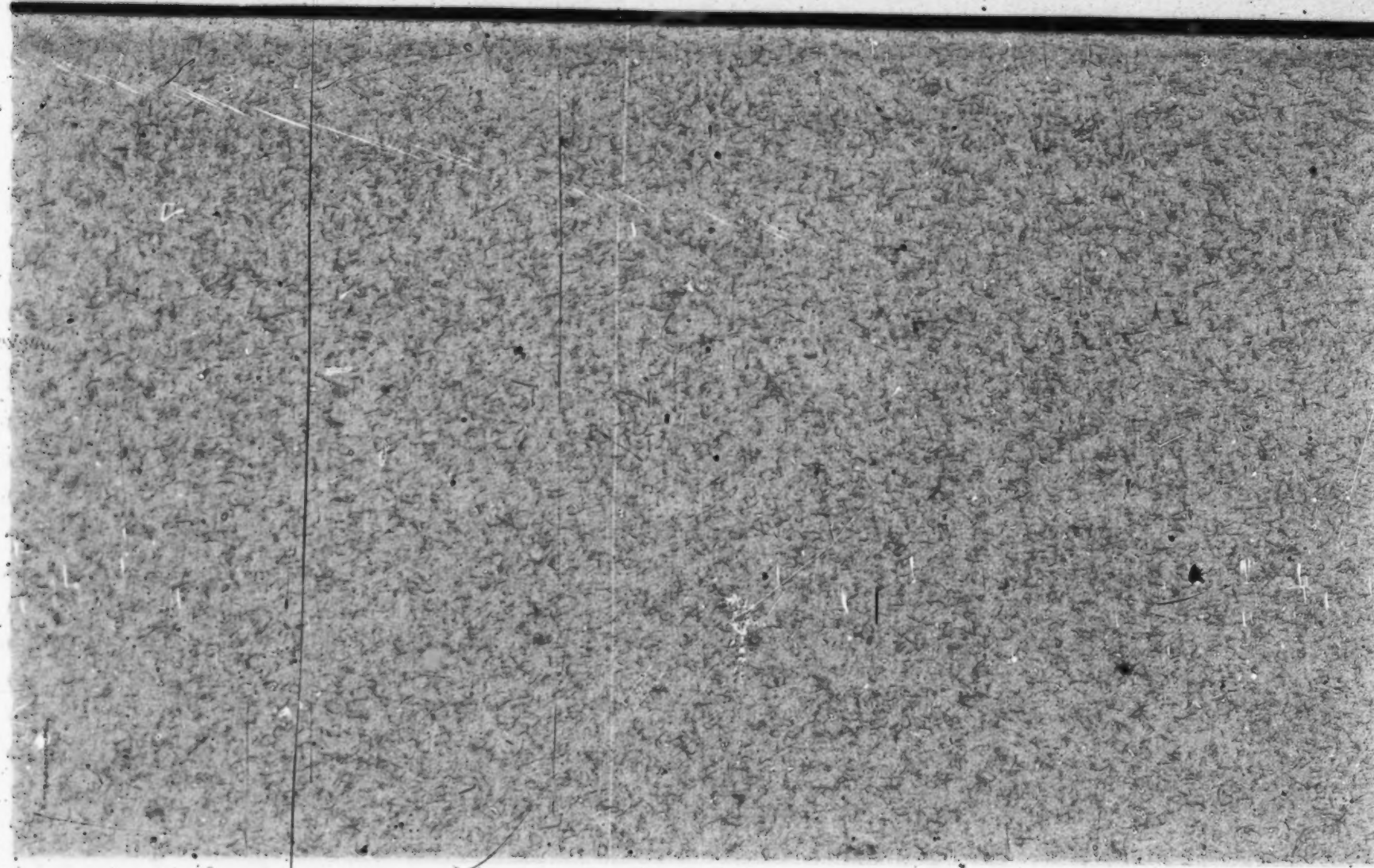
vs.

BINNEY & SMITH COMPANY.

PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

HUGH M. MORRIS,
Attorney for Petitioners.

GEORGE P. DIKE,
ARTHUR M. SMITH,
OSMAN E. SWARTZ,
Of Counsel.



INDEX.

Subject Index.

	Page
Petition for Writ of Certiorari	1
Summary and Short Statement of the Matter Involved	2
Jurisdiction	8
Questions Presented	9
Reasons Relied On for the Allowance of the Writ	10
Brief in Support of Petition	13
Statement	13
Specifications of Error	13
Summary of Argument	14
Argument	14
Point I.—The existing exigency with respect to rubber would seem to warrant an immediate review by this Court of the basis of the patent monopoly in question in that a product patent for carbon black in the form in which the rubber industry is now equipped to use it most advantageously, should not be permitted to aggravate in any way, for any time, the rubber situation unless that patent is found valid when tested by the decisions of this Court applicable thereto	14
Point II.—The Circuit Court of Appeals for the Fourth Circuit, in denying that the prior patent to Knowlton & Hoffman has any anticipating or invalidating effect upon the product claims in suit, decided a Federal question in a way probably in conflict with the applicable decision of this Court in *Cohn* v. *United States Corset Co.*, 93 U. S. 366, 377	16
Point III.—The Circuit Court of Appeals for the Fourth Circuit, in denying that the prior patent to Knowlton & Hoffman has any anticipating or invalidating effect upon the product claims in suit, decided a Federal question in a way probably in conflict with *Cohn* v. *United States Corset*	

Page

Co., 93 U. S. 366, 377, as understood and applied by the Circuit Court of Appeals for the Third Circuit in *General Electric Co.* v. *DeForest Radio Co.*, 28 F. (2d) 641; the Court of Appeals for the District of Columbia in *In Re Decker*, 36 App. D. C. 104; the Court of Customs and Patent Appeals in *In re Marden*, 48 F. (2d) 428; and in *In re Fink*, 62 F. (2d) 103, 104; and the prior decisions in the Fourth Circuit in *One-Piece Bifocal Lens Co.* v. *Bisight Co.*, 246 Fed. 450, affirmed 259 Fed. 275 18

Point IV.—The Circuit Court of Appeals for the Fourth Circuit, in adjudging the product claims in suit valid, notwithstanding prior art patents described granules, agglomerates or pellets of pulverulent material and the steps or processes by which such granules, agglomerates or pellets could be made, decided a Federal question in a way probably in conflict with applicable decisions of this Court in *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, *Densmore* v. *Scofield*, 102 U. S. 375, 378, and *Glue Co.* v. *Upton*, 97 U. S. 3 21

Point V.—The Court of Appeals for the Fourth Circuit, by its decision holding the claims in suit valid and infringed, recaptured for the patentee the subject-matter of claims that were cancelled and dedicated to the public, during the pendency of the application for the patent in suit, and, consequently, decided a Federal question in a way probably in conflict with applicable decisions of this Court in *Schriber Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, and in *Exhibit Supply Company* v. *Ace Patents Corporation*, No. 154, October Term, 1941, decided February 2, 1942. .. 22

Conclusion 23

Table of Cases Cited.

	Page
Altoona Theatres v. *Tri-Ergon Corp.*, 294 U. S. 464	9, 15
Bisight Co. v. *One-Piece Bifocal Lens Co.*, 259 Fed. 275	5, 11, 18
Buono v. *Yankee Maid Dress Corp.*, 77 F. (2d) 274, 279	19
Carbice Corp. v. *Am. Patents Corp.*, 283 U. S. 27	9, 15
Cohn v. *United States Corset Co.*, 93 U. S. 366, 377	9, 10, 11, 13, 17, 18, 20
Cuno Corp. v. *Automatic Devices Corp.*, 314 U. S. 84	7, 9, 11, 21
In re Decker, 36 App. D. C. 104	5, 11, 20
DeForest Radio Co. v. *Gen. Elec. Co.*, 283 U. S. 664	9, 15
Densmore v. *Scofield*, 102 U. S. 375, 378	7, 9, 11, 21
Exhibit Supply Co. v. *Ace Patents Corp.*, No. 154, October Term, 1941, decided February 2, 1942,	7, 10, 11, 23
In re Pink, 62 F. (2d) 103, 104	5, 20
Forsyth v. *Hammond*, 166 U. S. 506, 514	15
Fruit Growers, Inc. v. *Brogdex Co.*, 283 U. S. 1	9, 15
General Electric Co. v. *DeForest Radio Co.*, 28 F. (2d) 641	5, 11, 13, 18, 20
Glue Co. v. *Upton*, 97 U. S. 3	11, 21
Leitch Mfg. Co. v. *Barber Co.*, 302 U. S. 458, 461	9, 15
Los Alamitos Sugar Co. v. *Carroll* (C. C. A. 9), 173 Fed. 280, 285-286	6
Lynch v. *Headley*, 285 Fed. 1003, 1004 (Ct. of App. D. C.)	6
In re Marden, 48 F. (2d) 428	5, 11, 20
One-Piece Bifocal Lens Co. v. *Bisight Co.*, 246 Fed. 450	5, 11, 20
Schriber Co. v. *Cleveland Trust Co.*, 311 U. S. 211,	7, 9, 11, 15, 23

Authorities Cited.

R. S. §4886 (35 U. S. C. §31)	8
R. S. §4920 (35 U. S. C. §69)	8
U. S. Judicial Code, Sec. 24(7) (28 U. S. C. §41(7))	8
" " " " Sec. 240(a) (28 U. S. C. §347)	8
Walker on Patents, Deller's Ed. (p. 1222)	6

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

No. 1130

UNITED CARBON COMPANY AND UNITED CARBON COMPANY, INC.,

Petitioners,

vs.

BINNEY & SMITH COMPANY.

PETITION OF UNITED CARBON COMPANY AND UNITED CARBON COMPANY, INC., FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT.

To the Honorable the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioners, United Carbon Company and United Carbon Company, Inc., defendants, respectfully pray for a writ of certiorari to the Circuit Court of Appeals for the Fourth Circuit to review a judgment of that Court entered on March 11, 1942. A transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in accordance with the Rules of this Court.

Summary and Short Statement of the Matter Involved.

This action was brought by respondent in the Southern District of West Virginia to enjoin alleged infringement of Claims 1 and 2 of Letters Patent to Wiegand and Venuto No. 1,889,429 dated November 29, 1932. The District Court (Judge Barksdale) held these claims invalid and not infringed; but the Circuit Court of Appeals (opinion by Judge Parker) reversed the District Court on every essential finding of fact and held them valid and infringed.

Claims 1 and 2 of the patent are:

> "1. Substantially pure carbon black in the form of commercially uniform, comparatively small, rounded, smooth aggregates having a spongy or porous interior.
>
> "2. As an article of manufacture, a pellet of approximately one-sixteenth of an inch in diameter and formed of a porous mass of substantially pure carbon black."

The claims are not restricted to the product formed by the particular process described in the patent to Wiegand and Venuto. They call for the product broadly, irrespective of the method of its production. The process of the patent of Wiegand and Venuto is but one of several methods for forming granules of carbon black by agitating the carbon black *either in a dry or a wetted state*. Neither petitioners nor appellee uses the process of the patent in suit.

Carbon black is a fine powder deposited from the smoke of burning natural gas (R. 8). It is commercially pure when produced. It looks like black flour but it is much finer and more flocculent than the finest flour. It is an essential raw material used in several industries. In 1939, more than five hundred million pounds were produced (R. 12).

Approximately 90% of the carbon black produced has been used in the rubber industry as an ingredient of many rubber articles (R. 474, 477). When mixed with rubber,

carbon black greatly reduces the amount of rubber required. In some articles, the carbon black used is half as much as the rubber (R. 71). In many "rubber" articles, particularly tires, carbon black is indispensable. Carbon black greatly increases the life of the article in which it is incorporated. The resistance to wear of a rubber tire—the mileage obtainable therefrom—is directly dependent upon the use of carbon black as one of its ingredients. Tires made of rubber mixed with carbon black have a service life many times that of tires formerly made without carbon black as an ingredient (R. 12).

Carbon black was first used in powdered form. It competed with clay, barytes, talc, zinc oxide and other dusty powders then used as rubber fillers. Like the other powders, carbon black was packaged and shipped in paper bags. They required much transportation space and much man power in handling (R. 249). Like the other rubber fillers, it has been put in the granular or pellet form to compact it and thereby minimize the dust, and to facilitate transportation, handling and storage.

In 1918, long before Wiegand and Venuto, the patentees of the patent in suit, came into the field, Knowlton & Hoffman described, in their Patent No. 1,286,025 (R. 309), granules or pellets of pure carbon black which they called "friable grains or small lumps, dry and substantially free from dust". They incorporated their friable grains or small lumps with rubber in the usual way, stating "the friability of the lumps or grains permitting a uniform distribution of the filler throughout the rubber" (R. 309—11.29-31).

In 1925, still prior to Wiegand and Venuto, Coffin & Keen, in their Patent No. 1,561,971 (R. 317), described "spherical friable pellets" made of powdered rubber fillers such as

clay.[1] They taught the rubber industry that such pellets would flow by gravity; could be handled in bulk handling systems; were dustless; and were suitable for use "directly in the rubber mill", because a very slight pressure, such as that of the fingers, was sufficient to crush them (R. 320, lines 93-106 and R. 320, lines 121 to R. 321, line 5). Coffin & Keen's pellets differ from those of the patent in suit only in being made of powdered clay instead of carbon black.

The advantages claimed by Wiegand and Venuto for their product are the identical advantages inherent in and stated by Coffin & Keen for their pellets. The adroit phraseology of the claims in suit whereby Knowlton & Hoffman's "friable grains" became "small, rounded, smooth aggregates having a spongy or porous interior", no doubt played its part in securing the allowance of the claims and their validation by the Circuit Court of Appeals for the Fourth Circuit. (See, Hamilton Monograph No. 31—"Patents and Free Enterprises" p. 132).

About 1928 (R. 77) rubber manufacturers began installing closed "Banbury" milling equipment in their plants. This was followed by their installation of bulk handling equipment and closed conveyor systems (R. 162-163). When such installations were completed, the bulk shipment of carbon black granules in tank cars, and its transportation through the conveyor systems became so universal that now approximately 90% of the total annual output of car-

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[1] Coffin & Keen do not expressly mention carbon black, presumably because Knowlton & Hoffman's Patent No. 1,286,024 granted in 1918, described dried granules of pure carbon black made according to patent to Geer, No. 1,245,700, plus drying. Wiegand and Venuto produced, but by different process, the granules or pellets described by Knowlton & Hoffman (R. 309).

Neither the patent to Knowlton & Hoffman nor that to Coffin & Keen was cited by the Patent Office during the pendency of the application for the patent in suit.

bon black is shipped and handled in granular or pellet form.

The Circuit Court of Appeals denied to the patent of Knowlton & Hoffman any invalidating effect because, so the Court said, that patent does not describe a process for making the granules or pellets. It denied any invalidating effect to the patent to Coffin and Keen because, so the Court said, that patent nowhere discloses how to make the grains or pellets of carbon black (R. 488-489).

In so holding, the Circuit Court of Appeals misapplied or disregarded, it is believed, the decision of this Court in *Cohn* v. *United States Corset Co.*, 93 U. S. 366, 377, that it is quite immaterial that a prior patent set up as an anticipation of an article claim of a later patent is insufficient to teach a manufacturer how to make an article or product there described and that it is enough if the prior patent sufficiently describes the article; that "what is required is a description of the thing patented, not of the steps necessarily antecedent to its production".

Indeed, the decision of the Circuit Court of Appeals for the Fourth Circuit is also probably in conflict with the rule of the *Cohn* case as understood and applied in *General Electric Co.* v. *deForest Radio Co.*, 28 F. (2d) 641, decided by the Circuit Court of Appeals for the Third Circuit; *In Re Decker*, 36 App. D. C. 104, decided by the Court of Appeals of the District of Columbia, *In Re Marden*, 48 F. (2d) 428, and *In Re Fink*, 62 F. (2d) 102, 104, decided by the Court of Customs and Patent Appeals; and *One-Piece Bifocal Lens Co.* v. *Bisight Co.*, 246 Fed. 450, affirmed by the Circuit Court of Appeals for the Fourth Circuit in 259 Fed. 275.

But the patent to Knowlton & Hoffman, like the prior patent to Johnson set up as a defense in the *Cohn* case, did, it is believed, disclose a process for making their friable

grains of carbon black. That process was the process described by Geer in his patent No. 1,245,700, *plus drying.*[2]

The method of agitation used by Geer, i.e., agitation in an enclosed vessel containing rapidly revolving paddles, is identical with the Daisy churn which produced defendants' Exhibits DX-29, 30, 31. (R. 173-175.) The Daisy

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[2] Where a patent is an improvement on a prior patent which is referred to in the improvement patent, the latter should be read in connection with the former.

Walker on Patents, Dellers Ed., p. 1222;
Los Angeles Alamitos Sugar Co. v. *Carroll* (C. C. A. 9), 173 F. 280-285-6;
Lynch v. *Headley,* 285 Fed. 1003, 1004 (Ct. of App. D. C.).

Knowlton & Hoffman, in their patent No. 1,286,024, granted November 26, 1918, state:

> "We may use *water* or other volatile liquid *alone* as a concreting agent, first mixing enough of it with the lamp black to produce the desired condition, *and then drying the mass before mixing it with the rubber,* * * *".

At page 1, lines 58-63 (R. 309), the patent states:

> "We do not claim broadly the *granulation* of the powder with a volatile liquid before mixing with the rubber, *our invention being an improvement upon the process of that nature described in application of William C. Geer,* Serial No. 100,153 filed May 26, 1916."

By their reference to Geer, Knowlton & Hoffman disclosed that their water-alone process is the granulation process of Geer plus drying. Geer described his process saying, patent page 1, lines 18 *et seq.* (R. 311):

> "*I* find that by *mixing the powder with a suitable liquid* before it is introduced to the batch of rubber on the rolls of the mill, and *bringing the powder to a granular condition through the wetting of the particles and their concretion into grains,* the objection stated is entirely overcome.
>
> "Two liquids which I have successfully employed for this purpose are *water* and kerosene oil, *both* of which have the effect of rendering the gas-black *dustless* and *yet not pasty when mixed therewith in suitable proportions.* For example, I mix two parts, by weight, of gas black with one part of kerosene oil in a suitable closed vessel *which preferably contains rapidly-revolving paddles which assist the mixing and promote the attainment of the granular condition.*

Geer added:

> "The use of *water* gives an effect substantially the same as kerosene, * * *". (P. 1, lines 53-54).

churn is an enclosed vessel containing paddles which revolve.

By its decision adjudging the product claims here in issue valid, notwithstanding the prior art, and attributing to the patentees more ingenuity than is possessed by one skilled in the art, the Circuit Court of Appeals decided an important principle of patent law peculiarly affecting the public interests under the conditions now existing in a way probably in conflict with both the letter and spirit of the applicable decisions of this Court, and particularly *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, and *Densmore* v. *Scofield*, 102 U. S. 375, 378.

During the pendency of the application for the patent in suit, certain claims were cancelled and abandoned, for instance, Claim 7, which was (R. 334, 342):

> "7. A carbon black pellet formed of soft carbon black, the pellet having sufficient hardness to withstand ordinary shipment or handling without dusting, but sufficiently fragile to permit reduction to the original fine state of subdivision upon the application of light pressure."

By its decision validating the claims in suit and giving to them a meaning and construction which embraced the claims so abandoned and cancelled, the Circuit Court of Appeals recaptured from the public and for the patentee, the subject-matter of such cancelled and abandoned claims. Its decision so holding is believed to be in conflict with *Schriber Co.* v. *Cleveland Trust Co.*, 311 U. S. 211 and *Exhibit Supply Co.* v. *Ace Patents Corp.*, No. 154 October Term 1941, decided February 2, 1942.

By its decision apparently in conflict, upon fundamental principles of patent law, with the foregoing decisions of this Court, the Circuit Court of Appeals for the Fourth Circuit extended, it is believed, at the expense of the public and

with respect to a commodity which now peculiarly affects both the Nation and the public at large, the right to a patent monopoly beyond that authorized by R. S. §§ 4886 and 4920 (35 U. S. C. §§ 31 and 69).

Rubber mixed with carbon black has innumerable uses in our war time economy, in addition to the all-important automotive tires. It is the material used for resilient tank treads, rubber footwear, and various types of mechanical rubber goods. The product claims in suit affect immediately or mediately, under the peculiar conditions now existing, not only the carbon black industry and the rubber industry, but through those industries the armed forces of the Nation and substantially every private citizen of America.

The conditions with which the American people are now confronted with respect to rubber, transportation space, and man power, make essential that carbon black, in the form in which it can now be most economically and advantageously used by the rubber industry, should not be required to remain subject to a patent monopoly for any period of time, however short, unless the patent in which such monopoly is asserted is a rightful one, under the patent statutes, when tested by the decisions of this Court.

Jurisdiction.

(1) This is a suit arising under the Patent Laws of the United States, Judicial Code, Sec. 24(7), (28 U. S. C. § 41(7)).

(2) The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U. S. C. § 347).

(3) The date of the judgment which petitioner seeks to have reviewed is March 11, 1942, on which date the Circuit

Court of Appeals for the Fourth Circuit denied the petitioner's petition for rehearing.

(4) Cases believed to sustain the jurisdiction are:

Fruit Growers Inc. v. *Brogdex Co.*, 283 U. S. 1;
DeForest Radio Co. v. *Gen. Elec. Co.*, 283 U. S. 664;
Altoona Theatres v. *Tri-Ergon Corp.*, 294 U. S. 464;
Schriber Co. v. *Cleveland Trust Co.*, 311 U. S. 211;
Carbice Corp. v. *Am. Patents Corp.*, 283 U. S. 27;
Leitch Mfg. Co. v. *Barber Co.*, 302 U. S. 458, 461.

Questions Presented.

1. Does a prior patent which describes a product but which does not describe a process by which that product can be made, fail on that account to anticipate a later patent which claims that product?[3]

2. Does a prior patent which describes a product but refers to another patent for certain steps of the process by which the product is to be made, sufficiently meet the requirements of § 4886 as to anticipation by prior patents and printed publications?

3. Did the Circuit Court of Appeals, in adjudging the product claims valid and appraising the rights of the public under the prior art patents, misunderstand, misinterpret and misapply the principles governing invention and the respective rights of patentees and the public, enunciated by this Court in *Densmore* v. *Scofield*, 102 U. S. 375, 378 and in *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84?

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[3] It is believed that this question was answered, and in the negative, by this Court in *Cohn* v. *The United States Corset Company*, 93 U. S. 366, 377. If, however, it was not there decided, it is a question of such gravity and importance in the Patent Law and to the public that it should be settled by this Court. The Circuit Court of Appeals answered the question in the affirmative.

4. Did the Court of Appeals depart from the decisions of this Court in *Schriber Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, and in *Exhibit Supply Company* v. *Ace Patents Corporation*, No. 154 October Term, 1941, in holding Claims 1 and 2 of the patent in suit valid and infringed and thereby recapture from the public and for the patentee the subject-matter of cancelled claims which had been eliminated from the patent application and dedicated to the public?

5. Did the Court of Appeals in adjudging the claims in issue infringed by defendant's product, give to those claims a construction which recaptured from the public and for the patentee, subject-matter in the public domain?

Reasons Relied On for the Allowance of the Writ.

I. The existing exigency with respect to rubber would seem to warrant an immediate review by this Court of the basis of the patent monopoly in question in that a product patent for carbon black in the form in which the rubber industry is now equipped to use it most advantageously, should not be permitted to aggravate in any way, for any time, the rubber situation unless that patent is found valid when tested by the decisions of this Court applicable thereto.

II. The Circuit Court of Appeals for the Fourth Circuit, in denying that the prior patent to Knowlton & Hoffman has any anticipating or invalidating effect upon the product claims in suit, decided a federal question in a way probably in conflict with the applicable decision of this Court in *Cohn* v. *United States Corset Company*, 93 U. S. 366, 377.

III. The Circuit Court of Appeals for the Fourth Circuit, in denying that the prior patent to Knowlton & Hoffman has any anticipating or invalidating effect upon the product claims in suit, decided a federal question in a way probably in conflict with *Cohn* v. *United States Corset Com-*

pany, 93 U. S. 366, 377, as understood and applied by the Circuit Court of Appeals for the Third Circuit in *General Electric Co.* v. *DeForest Radio Co.*, 28 F. (2) 641; the Court of Appeals for the District of Columbia in *In Re Decker*, 36 App. D. C. 104; the Court of Customs and Patent Appeals in *In Re Marden*, 48 F. (2d) 428; and *In Re Fink*, 62 F. (2d) 103, 104; and the prior decisions in the Fourth Circuit in *One-Piece Bifocal Lens Co.* v. *Bisight Co.*, 246 Fed. 450, affirmed 259 Fed. 275.

IV. The Circuit Court of Appeals for the Fourth Circuit, in adjudging the product claims in suit valid, notwithstanding prior art patents described granules, agglomerates or pellets of pulverulent material and the steps or processes by which such granules, agglomerates or pellets could be made, decided a federal question in a way probably in conflict with applicable decisions of this Court in *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, *Densmore* v. *Scofield*, 102 U. S. 375, 378, and *Glue Co.* v. *Upton*, 97 U. S. 3.

V. The Court of Appeals for the Fourth Circuit, by its decision holding the claims in suit valid and infringed, recaptured for the patentee the subject-matter of claims that were cancelled and dedicated to the public, during the pendency of the application for the patent in suit, and, consequently, decided a federal question in a way probably in conflict with applicable decisions of this Court in *Schriber Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, and in *Exhibit Supply Company* v. *Ace Patents Corporation*, No. 154 October Term 1941, decided February 2, 1942.

WHEREFORE, your petitioners respectfully pray that a writ of certiorari be issued out of and under the seal of this Court, directed to the United States Circuit Court of Appeals for the Fourth Circuit, commanding such Court to

certify and send to this Court, on a day to be designated, a full transcript of the record and all proceedings of the Court of Appeals had in this case, to the end that this case may be reviewed and determined by this Court; that the judgment of the Court of Appeals be reversed; and that petitioners be granted such other and further relief as may seem proper.

HUGH M. MORRIS,
Attorney for Petitioners.

GEORGE P. DIKE,
ARTHUR M. SMITH,
OSMAN E. SWARTZ,
Of Counsel.

Dated: April 9, 1942.

BRIEF IN SUPPORT OF PETITION.

Opinions of the Courts Below.

The opinion of the District Court in the form of findings of fact and conclusions of law is reported in 37 Fed. Supp. 779. It is also printed at R. 1-4.

The opinion of the Circuit Court of Appeals is reported at 125 Fed. (2d) 255 and is set out in the printed record at page R. 483-491.

The opinion of the Circuit Court of Appeals denying the petition for rehearing is not yet reported. It is printed in the record at page 494-495.

Statement.

The facts are believed to be sufficiently stated in the petition.

Specifications of Error.

The errors which petitioner will urge, if the writ of certiorari is allowed, are that the Circuit Court of Appeals for the Fourth Circuit erred,

(1) In not adjudging Claims 1 and 2 of Patent to Wiegand and Venuto, No. 1,889,429, invalid in view of *Cohn* v. *United States Corset Co.*, 93 U. S. 366, 377; and *General Electric Co.* v. *DeForest Radio Co.*, 28 F. (2d) 641 (affirming 17 F. (2d) 90, 98-101), because of the prior patent to Knowlton & Hoffman, No. 1,286,024;

(2) In not adjudging Claims 1 and 2 of Patent to Wiegand and Venuto, No. 1,889,429, invalid in view of *Cohn* v. *United States Corset Co.*, 93 U. S. 366, 377, because the prior patent to Knowlton & Hoffman, No. 1,286,024, when read in connection with the prior patent to Geer, No. 1,245,700, taught those skilled in the art how to produce the product of the claims in suit;

(3) In not adjudging Claims 1 and 2 of patent to Wiegand and Venuto, No. 1,889,429, invalid in view of *Cuno Corp.* v.

Automatic Devices Corp., 314 U. S. 84 and *Glue Co.* v. *Upton*, 97 U. S. 3, because the patents of the prior art had described granules, agglomerates or pellets, like those of the claims in suit, made from the same or analogous pulverulent material and had disclosed how to make them;

(4) In so departing from the decisions of this Court, in holding Claims 1 and 2 of the patent in suit infringed by defendant's product, as to recapture from the public and for the patentee the subject-matter of cancelled Claims which had been eliminated from the patent application and dedicated to the public.

(5) In sustaining Claims 1 and 2 of Patent to Wiegand and Venuto, No. 1,889,429, as valid and infringed; and

(6) In failing to adjudge Claims 1 and 2 of Patent to Wiegand and Venuto, No. 1,889,429, invalid as completely anticipated by, and wanting in invention over, the prior art.

Summary of Argument.

The points of the argument are the reasons relied on for the allowance of the writ, printed at pages 10 and 11 of the petition.

ARGUMENT.

Point I.

The existing exigency with respect to rubber would seem to warrant an immediate review by this Court of the basis of the patent monopoly in question in that a product patent for carbon black in the form in which the rubber industry is now equipped to use it most advantageously, should not be permitted to aggravate in any way, for any time, the rubber situation unless that patent is found valid when tested by the decisions of this Court applicable thereto.

Exceptional circumstances peculiarly affecting the public are sometimes deemed sufficient to warrant the granting of

the writ to examine the soundness of a decision of a Circuit Court of Appeals, even in the absence of conflicting decisions as to the validity of the patent involved.

A few instances are:

Fruit Growers Inc. v. *Brogdex Co.*, 283 U. S. 1;
DeForest Radio Co. v. *Gen. Elec. Co.*, 283 U. S. 664;
Altoona Theatres v. *Tri-Ergon Corp.*, 294 U. S. 464;
Schriber Co. v. *Cleveland Trust Co.*, 311 U. S. 211;
Carbice Corp. v. *Am. Patents Corp.*, 283 U. S. 27;
Leitch Mfg. Co. v. *Barber Co.*, 302 U. S. 458, 461.

Such exceptional circumstances are not restricted to those arising from facts of any particular character. The power of the Court is "coextensive with all possible necessities". *Forsyth* v. *Hammond*, 166 U. S. 506, 514.

The existing conditions with respect to rubber, the relation of carbon black[4] to that commodity, and the aggravation of those conditions to the injury of both the Nation and the people, if carbon black in granular or pellet form is illegally monopolized, earnestly press—with convincing cogency, it is believed—for the granting of the writ.

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[4] Of the total pelleted carbon black used by the rubber industry in 1939, approximately 97,000,000 pounds were supplied by respondent (R. 37), 98,000,000 pounds by petitioners (R. 201), 73,000,000 pounds by The Cabot Company (R. 163) and the bulk of the remainder by three or four others. Ninety percent of the total carbon black production was in the form of pellets or granules.

Point II.

The Circuit Court of Appeals for the Fourth Circuit, in denying that the prior patent to Knowlton & Hoffman has any anticipating or invalidating effect upon the product claims in suit, decided a Federal question in a way probably in conflict with the applicable decision of this Court in Cohn v. United States Corset Company, 93 U. S. 366, 377.

In its opinion, the Circuit Court said (R. 488):

> "The Knowlton & Hoffman patent speaks of the granulation of the carbon black by mixing it with a volatile liquid and then drying it; but *it does not disclose how this is to be done* * * *".

In the decision on the petition for rehearing, the Court reiterated its statement that the Knowlton & Hoffman patent did not teach how the pellets or granules were to be made (R. 495).

At page 1, lines 21-36 of their patent (R. 309), Knowlton & Hoffman, after referring to gas-black as a species of lamp black, said:

> "Instead of using the lamp black in its natural condition, we prepare and treat the fine powder so as to cause its concretion into *friable grains or small lumps, dry and substantially free from dust*, and in this form incorporated with the rubber on the roller mill or in any suitable masticating apparatus heated in the usual way to soften the rubber, *the friability of the lumps or grains permitting a uniform distribution of the filler throughout the rubber.*"
>
> "We may use water or other volatile liquid alone as a concreting agent, first mixing enough of it with the lamp black to produce the desired condition, and then drying the mass before mixing it with the rubber * * *".

The "friable grains or small lumps, dry and substantially free from dust" of Knowlton & Hoffman, the friability of which permits a uniform distribution of the filler throughout the rubber, is the product called for by the product claims here in issue (R. 309).

We submit that the Knowlton & Hoffman patent describes completely the thing patented by the claims of the patent in suit.

In *Cohn* v. *United States Corset Company*, 93 U. S. 366, the matter decided is stated at page 377 thus:

> "The plaintiff claims a manufacture, not a mode, of making it; and the important inquiry, therefore, is whether the prior publication described the article. To defeat a party suing for an infringement, it is sufficient to plead and prove that the thing patented to him had been patented or described in some printed publication prior to his supposed invention or discovery thereof. Rev. Stat. sect. 4920. What is required is a description of the thing patented, not of the steps necessarily antecedent to its production."

Thus, even if it be assumed [5] that Knowlton & Hoffman did not disclose how to make their "friable grains or small

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[5] Both this assumption and the findings of the Circuit Court of Appeals that Knowlton & Hoffman did not disclose how to make their product, are, it is believed, contrary to the fact. The commercial processes of both petitioners and appellee are substantially the process of Knowlton & Hoffman. Neither uses the process of the patent in suit.

In *Cohn* v. *United States Corset Co.*, 93 U. S. 366, 377, this Court, after adjudging the patent in suit invalid by reason of the description of the patented article in the prior patent to Johnson, even if that patent did not teach how to make the patented corset, said:

> "But the evidence shows that the Johnson specification, in connection with the known state of the art at the time when it was filed and published, was sufficient to enable one skilled in the art of corset making and in the use of jacquard to make the patented corset."

So it is here,—the Knowlton & Hoffman specification, when read in connection with the known state of the art, as exemplified by the Geer patent, was sufficient to enable one skilled in the art to make granular or pellet carbon black.

lumps, dry and substantially free from dust", nevertheless the decision of the Circuit Court of Appeals is probably in conflict with the decision of this Court in *Cohn* v. *United States Corset Company*, 93 U. S. 366, 377, which held that a description of the process was not necessary to anticipate a claim for a product.

POINT III.

The Circuit Court of Appeals for the Fourth Circuit, in denying that the prior patent to Knowlton & Hoffman has any anticipating or invalidating effect upon the product claims in suit, decided a Federal question in a way probably in conflict with Cohn v. United States Corset Company, 93 U. S. 366, 377, as understood and applied by the Circuit Court of Appeals for the Third Circuit in General Electric Co. v. De Forest Radio Co., 28 F. (2d) 641; the Court of Appeals for the District of Columbia in In re Decker, 36 App. D. C. 104; the Court of Customs and Patent Appeals in In re Marden, 48 F. (2d) 428; and in In re Fink, 62 F. (2d) 103, 104; and the prior decisions in the Fourth Circuit in One-Piece Bifocal Lens Co. v. Bisight Co., 246 Fed. 450, affirmed 259 Fed. 275.

In *General Electric Co.* v. *DeForest Radio Co.*, 17 F. (2d) 90, 98-101, the District Court for the District of Delaware, recognizing and applying the principle enunciated in *Cohn* v. *United States Corset Co.*, 93 U. S. 366, 377, dismissed the bill of complaint.

The Circuit Court of Appeals for the Third Circuit, in *General Electric Co.* v. *DeForest Radio Co.*, 28 F. (2d) 641, affirmed the decision of the District Court in that case with respect to the product claims.

At 28 F. (2d) 641, 644, Judge Woolley, speaking for that court, said:

> "Given the knowledge of the art and particularly the disclosures of Just and Hanaman as to the advantages

of a tungsten filament and given pure tungsten with its natural characteristics of great ductility and high tensile strengh, the drawing of such tungsten into a wire for filament purposes was obvious. In this judgment we are abundantly fortified, not only by the evidence in this case and the litigious history of tungsten but by the undisputed fact that *many scientists, prominent among whom was Coolidge, had long recognized the value of tungsten wire filament and had long tried to produce ductile tungsten so that they could draw wire filaments from it.* In other words, the idea of 'tungsten wire' ran ahead of the production of ductile tungsten so that when ductile tungsten was finally produced the drawing of it into wire was a thing long intended and therefore obvious. We are of opinion that given ductile tungsten there is no more invention in drawing it into a wire than there is in rolling it into a plate, pressing it into a bar, or forging it into a tube."[6]

The Circuit Court of Appeals for the Fourth Circuit in the present case denied any invalidating effect to a prior patent which described the product of the claims in suit, saying:

"The Knowlton & Hoffman patent speaks of the granulation of the carbon black by mixing it with a volatile liquid and then drying it; but it does not disclose how this is to be done * * *".

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[6] The District Court had held (17 Fed. 2d, 90, 98-102):

"that the mental part of the invention of the product resides in the idea or conception of that product as a means to an end, is complete when there is a definite idea of the thing itself *even without a knowledge on the part of any one of how to make that thing,* and that, when fully disclosed as in a publication, the completed conception has the effect in law of denying to one thereafter making the thing so previously conceived of a patent for the thing, and restricting the latter's reward to a patent for his process."

That view seems fortified by the statement of Judge Learned Hand in *Buono* v. *Yankee Maid Dress Corp.*, 77 Fed. (2d) 274, 279 (C. C. A. 2), that invention

"must lie exclusively in the conception of the product and regardless of any method of its production, * * *".

That decision is believed to be in direct conflict, not only with *Cohn* v. *United States Corset Co.*, 93 U. S. 366, 377, but as well in conflict with the decisions of the Circuit Court of Appeals for the Third Circuit in *General Electric Co.* v. *DeForest Radio Co.*, 28 Fed. (2d) 641; *In re Decker*, 36 App. D. C. 104, decided by the Court of Appeals for the District of Columbia; *In re Marden* (C. C. P. A.), 48 Fed. (2d) 428; and with the prior decisions in the Fourth Circuit in *One-Piece Bifocal Lense Co.* v. *Bisight Co.*, 246 Fed. 450, affirmed 259 Fed. 275.

In *In re Fink*, 62 Fed. (2d) 102, 104, the Court of Customs and Patent Appeals, whose decisions govern the Patent Office tribunals, stated:

> "* * * A patent which describes an article with sufficient clearness to define that article, is a reference for an article claim *even if the process disclosed will not produce that article.*"

The patent to Knowlton & Hoffman was not cited by the Patent Office as a reference against the claims in suit. Had it been cited, the law as stated in *In re Fink* would have prevented the allowance of the claims here in issue. The decision of the Circuit Court of Appeals in the case at bar thus not only creates confusion, doubt and uncertainty as to the rule laid down by this Court in the *Cohn* case, but it establishes, at the expense of the public, a standard of patentability that is in direct conflict with the decisions of the Court of Customs and Patent Appeals by which the Patent Office tribunals are governed in the granting of patents.

It would seem manifest that the necessity, in the public interest, of having the principle of law enunciated by this Court in the *Cohn* case freed from doubt, would not be

made greater by a conflict of decisions of Circuit Courts of Appeals with respect to the validity of the product claims here in issue.

POINT IV.

The Circuit Court of Appeals for the Fourth Circuit, in adjudging the product claims in suit valid, notwithstanding prior art patents described granules, agglomerates or pellets of pulverulent material and the steps or processes by which such granules, agglomerates or pellets could be made, decided a Federal question in a way probably in conflict with applicable decisions of this Court in Cuno Corp. v. Automatic Devices Corp., 314 U. S. 84, Densmore v. Scofield, 102 U. S. 375, 378, and Glue Co. v. Upton, 97 U. S. 3.

The decision of the Circuit Court of Appeals for the Fourth Circuit is contrary to the line of recent decisions of this Court reaffirming the standard of what constitutes invention and distinguishing between mere skill of the art and the spark of genius which constitutes invention.

In view of the prior patents referred to in the petition, there was no spark of genius in making still another powdered substance into pellets or granules. Accordingly, it is believed that the decree of the District Court dismissing the bill should have been affirmed by the Circuit Court of Appeals under the rule declared in *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84; *Densmore* v. *Scofield*, 102 U. S. 375, 378, and *Glue Co.* v. *Upton*, 97 U. S. 3.

POINT V.

The Court of Appeals for the Fourth Circuit, by its decision holding the claims in suit valid and infringed, recaptured for the patentee the subject-matter of claims that were cancelled and dedicated to the public, during the pendency of the application for the patent in suit, and, consequently, decided a Federal question in a way probably in conflict with applicable decisions of this Court in Schriber Co. v. Cleveland Trust Co., 311 U. S. 211, and in Exhibit Supply Company v. Ace Patents Corporation, No. 154, October Term, 1941, decided February 2, 1942.

Original Claim 7 (R. 334) was cancelled (R. 342). It was:

> "7. A carbon black pellet formed of soft carbon black, the pellet having sufficient hardness to withstand ordinary shipment or handling without dusting, but sufficiently fragile to permit reduction to the original fine state of subdivision upon the application of light pressure."

Original Claim 4 (R. 334) was rejected by the Examiner (R. 363, 371). It was:

> "4. A pellet formed of substantially pure soft carbon black particles, the pellet being sufficiently hard to withstand ordinary shipment or handling, but readily breaking down to a fine state of subdivision upon the application of slight pressure."

Upon appeal to the Board of Appeals, the decision of the Examiner was affirmed (R. 383).

The Circuit Court of Appeals for the Fourth Circuit, in its opinion, said (R. 487):

> "The product of the patent solved not only this problem (dust) but also problems connected with handling and transportation. It did this by agglomerating tiny particles of the powdered product into small granules

or pellets which were dustless, which were flowable, and which would disintegrate in the process of rubber manufacture so as to preserve the advantages of the dispersability of the tiny particles."

Thereby, that Court recaptured from the public and gave to the plaintiff as a monopoly, the subject-matter of the foregoing cancelled claims which had been eliminated from the patent application and dedicated to the public. In so doing, the Circuit Court of Appeals decided a Federal question in a way probably in conflict with applicable decisions of this Court in *Schriber Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, and in *Exhibit Supply Co.* v. *Ace Patents Corp.*, No. 154 October Term, 1941, decided February 2, 1942.

Conclusion.

WHEREFORE, the petitioners earnestly pray that the petition for writ of certiorari be granted, the cause reviewed, and the decree of the Circuit Court of Appeals for the Fourth Circuit reversed.

Respectfully submitted,

HUGH M. MORRIS,
Attorney for Petitioners.

GEORGE P. DIKE,
ARTHUR M. SMITH,
OSMAN E. SWARTZ,
Of Counsel.